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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/709,647	05/19/2004	Joshua G. Breier	PU2167	3646
23454	7590	06/09/2005	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			PASSANITI, SEBASTIANO	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/709,647

Applicant(s)

BREIER ET AL.

Examiner

Sebastiano Passaniti

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 05/19/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is responsive to communication received 05/19/2004 – application papers filed; 08/20/2004 – Response to Notice to File Corrected Papers and drawings filed.

Claims 1-11 are pending.

Following is an action on the MERITS:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by HONMA. As to claim 1, reference is made to Figures 1, 2 and 3 along with col. 2, line 66 through col. 4, line 59 showing and detailing a club head body having a front face (4) with a recessed portion (not numbered). An insert (6) is fitted within the recessed portion. The insert (6) further comprises a face plate or element (9) attached to an indented portion of the insert (6). Note that Honma states that element (9) is embedded within the insert (6). Here, the face plate is made of high density material such as brass. The face plate clearly takes up less than 90% of the exterior of the insert (6). As

Art Unit: 3711

to claim 3, Honma states that screws are used to secure the insert (6) within the recess of the main body (col. 3, lines 5-9).

Claims 2, 5 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over HONMA in view of HELMSTETTER ('302). Honma differs from the claimed invention in that Honma does not show a plurality of tabs, as claimed. Helmstetter shows it to be old in the art of golf club heads, whether putter, irons or woods, to hold an insert within the opening of a main club head body via a plurality of tabs arranged around the perimeter of the insert for ease of assembly. Note col. 2, line 48 through col. Col. 3, line 39 and col. 6, line 65 through col. 7, line 32 in Helmstetter. In view of the patent to Helmstetter, it would have been obvious to modify the device in the cited art reference to Honma by fixing the insert (6) within the recessed portion of the main club head body using a plurality of tabs as an alternative to the screws employed, the motivation being to simply make use of another convenient mechanical expedient that is useful for mating an insert within a recess.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over HONMA in view of STRAZA. To have modified the device in HONMA by introducing epoxy adhesive to the interior of the insert (6) in order to more steadfastly secure the insert within the main body portion would have been obvious in view of the patent to Straza, which shows it to be old in the art to secure an insert (26) within the recessed portion of a wood-type club head such that no additional attachment means are required to secure the insert. See col. 2, line 60 through col. 3, line 38 in Straza.

Claims 6, 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over HONMA. Although Honma does not detail the exact materials required by the claims, the skilled artisan would have found it obvious to select suitable materials for the insert and face plate based upon the natural characteristics of these materials. It has long been established in the Patent laws that the selection of a known material to take advantage of its known properties would have been obvious to the skilled artisan. See In re Hopkins 145 USPQ 140. Moreover, it is clear that the applicant has not invented the claimed materials, per se. In addition, the applicant has merely disclosed that the claimed materials are simply preferred. Therefor, the exact polymer material for the insert and the exact metal selected for the face plate is not especially critical.

Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over HONMA in view of FISHER ('132). The patent to Honma differs from the claimed invention in that Honma is not directed to clubs of the putter-type. Instead, Honma relates to a wood-type club head. Fisher shows it to be old in the art to extend the teachings associated with the placement of an insert within the main club head body to include all types of club heads, namely, putters, irons and woods. See Figures 1, 8 and 11 in Fisher. As each of a wood, iron and putter are routinely used by a golfer during a round of golf, the skilled artisan would have found it obvious to modify the device in the cited art reference to Honma by extending the teachings of an insert having a polymer base and a metal face plate attached therein to include other styles of club heads. As for the specific material concerns required by claims 10 and 11, note the comments

Art Unit: 3711

above with respect to Honma as applied to claims 6, 8 and 9. No further explanation is deemed necessary, here.

Claims 2, 5, 7 and 11 are objected to because of the following informalities:

As to claims 2, 5 and 7, these claims refer to "the plurality of tabs" that supposedly are part of claim 1. While the context of the claim is understood for purposes of applying the prior art, it is noted that "the plurality of tabs" fails to appear in claim 1.

As to claim 11, line 1, should not "19" be --1-- ?

Appropriate correction is required.

The IDS received 05/19/2004 has been considered. However, applicant's attention is drawn to the second page of the IDS wherein at entries "26" and "27", the same US Patent No. D428457 has been identified with two different Patentees. An explanation and/or correction are respectfully requested.


The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the tabs in Figure 1 in Lo. See the tabs in Figure 16 of Rowland. Krumme, Guerne, Shieh and Delaney show inserts, of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Mon-Fri (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3711

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Sebastiano Passaniti
Primary Examiner
Art Unit 3711

S.Passaniti/sp
June 8, 2005